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OFFICE OF PETITIONS

In re Application of
Joseph Rogozinski
Application No. 10/806,231
Filed: March 23, 2004
Attorney Docket No. 1231ROG-US

ON PETITION

This is a decision on the "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on August 17, 2005.

This application became abandoned for failure to reply timely to the Notice to File Corrected Application Papers mailed on June 4, 2004, which set a two-month extendable period to respond. Petitioner did not obtain any extensions of time for response. Accordingly, this application became abandoned on August 5, 2004. A Notice of Abandonment was mailed on February 18, 2005.

On March 16, 2005, petitioner filed a petition under 37 CFR 1.137(a) with the requisite petition fee, which was dismissed for failing to show that the entire period of delay was unavoidable. On August 17, 2005, petitioner filed to present petition for revival of the above-identified application. However, petitioner indicated the he paid a \$250.00 petition fee for filing the petition under 37 CFR 1.137(a) on March 16, 2005. Petitioner stated that the "[t]otal fee owed is thus \$750.00 - \$250 = \$500." In accordance with petitioner's instruction, the USPTO mistakenly applied the \$250.00 petition fee paid on March 16, 2005, for filing the petition under 37 CFR 1.137(a), towards the \$750.00 petition fee owed for filing the present petition.

The Office reminds petitioner that a grantable petition under 37 CFR 1.137(b) **must be accompanied by:** (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) **the petition fee as set forth in 1.17(m)**; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(d). However, petitioner did not submit the entire amount of \$750.00 on filing the present petition under 37 CFR 1.137(b).

Pursuant to 35 U.S.C. 41(a) (7), the Director shall charge the petition fee set forth in 37 CFR 1.17(m) on filing a petition for the revival of an unintentionally abandoned application. Unless the circumstances warrant the withdrawal of the holding of abandonment (*i.e.*, it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a **statutory prerequisite to revival of the abandoned application**, and cannot be waived. Furthermore, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Thus, the Office: (1) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (2) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

On March 16, 2005, petitioner was required to pay the \$250.00 petition fee on filing the petition under 37 CFR 1.137(a) as a statutory prerequisite to revival of the abandoned application. Moreover, petitioner is not entitled to apply the \$250.00 petition fee towards the \$750.00 petition fee required on filing the present petition because the Office will not refund the \$250.00 fee regardless of the fact that the petition under 37 CFR 1.137(a) was dismissed. Accordingly, the Office will not reach the merits of the present petition until petitioner submit both a "Renewed Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," and the outstanding balance of \$250.00 for filing the petition under 37 CFR 1.137(b) within **TWO (2) MONTHS** of the mailing date of this decision. No extensions of time are permissible.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell**:

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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

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